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EXAMINER	
FISHER, PAUL R	

ART UNIT	PAPER NUMBER
3689	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/790,469	MUELLER, SCOTT	
	Examiner	Art Unit	
	PAUL R. FISHER	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/3/2004, 4/4/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is a first Office Action Non-Final rejection on the merits. Claims 1-25 are subject to a restriction requirement and the applicant has chosen claims 1-17 without traverse see restriction below. Claims 1-17 are currently pending and have been considered below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-17, drawn to evaluating potential sales and business opportunities, classified in class 705, subclass 1.

II. Claims 18-25, drawn to calculating the return on investment, classified in class 705, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions I and II are directed to two different processes. Invention I is directed toward calculating the potential sales and business opportunities, while Invention III is directed toward calculating return on investment. These two processes have distinct and separate utility, the calculation of projected sales and business opportunities in invention I is not used to calculate the return on investment calculation in invention III. Likewise the calculation of return on investment in invention III is not used in the calculation of projected sales or business opportunities in invention I, thus these two

inventions are not disclosed as capable of being used together and have different modes of operation and end results.

4. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

(a) the inventions have acquired a separate status in the art in view of their different classification;

(b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

(c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention**.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. During a telephone conversation with Marc McSwain (44,929) on February 19, 2009 a provisional election was made without traverse to prosecute the invention of group I, claims 1-17. Affirmation of this election must be made by applicant in replying to this Office action. Claim18-25 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: It is unclear to the Examiner how the information being collected is used in the calculations. Further it is unclear how the various calculations are tied together and what they are used for. Currently the method claims collecting, calculating, determining and calculating of various forms of data. However, the claims fails to meet the score of the preamble since no evaluation has been performed using the calculations and there was no evaluation has been made on the business opportunities. Simply put the claims as currently written only require the collection of information and calculations that aren't being used.

Further in claims 3 and 13 introduce new data but doesn't explain how it changes the limitations mentioned in the associated independent claims.

Claims 6, 8 15 and 17, introduce known calculations but fail to describe how these calculations tie to the previous limitations of the independent claims.

9. The term "about" in claims 4, 5 and 14 is a relative term which renders the claims indefinite. The term "about" is not defined by the claim, the specification does not

provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear to the Examiner what the degree is for "about" and how it corresponds to the tread index and how this percentage further changes the limitations of the corresponding independent claims.

10. In claim 10, the term "warranty factor" renders the claim indefinite. It is unclear to the Examiner what a warranty factor is and how one of ordinary skill would know how to calculate this factor. For the purposes of examination the Examiner is taking this factor to be the cost of paying for warranty claims.

11. In claim 11, the term "loyalty variable" renders the claim indefinite. It is unclear to the Examiner what a loyalty variable is and how one of ordinary skill would know how to calculate this variable. For the purpose of examination the Examiner is taking this variable to determine how often a customer will remain with the service provider.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 1-17 are rejected under 35 U.S.C. 101 because based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiner is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook,

437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

To qualify as a § 101 statutory process, the claim should recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. **Claims 1-5, 7, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burris et al. (US 2003/0208394 A1) hereafter Burris, in view of James H. Byrd: "Manage Your Inventory in Excel" (August 10, 2002) hereafter Byrd.**

As per claim 1, Burris discloses a method of evaluating potential sales and business opportunities relating to establishing sales (Page 1, paragraph [0001];

discloses that the invention is directed toward tracking and forecasting sales) comprising:

collecting operational data from the service center (retail outlet), wherein the operational data comprises an average number of repair order requests (average sales), hours of operation, and identification of one or more carlines serviced (products) (Page 1, paragraph [0003]; discloses that it is old and well known to collect various forms of data, from various sources in order to predict potential sales, Page 1, paragraph [0015]; discloses that various sources of data are obtained, Page 3, paragraph [0028]; discloses that the information can be created based on the needs of the specific user. While the information gathered is not the same since no specific industry is mentioned in Burris, the Examiner asserts that the information itself would have been obvious to one of ordinary skill in the tire industry since it would have been obvious to know the number of requests, the hours of operation and the different products being sold all of this information would have been needed in calculating the potential sales);

calculating a maximum expected number of tires (products sold) which may be sold for each carline per time period, wherein the maximum is equal to the average number of repair order requests multiplied by the number of days the service center is open per time period multiplied by four (4) tires multiplied by a tire tread index (which is the percentage of vehicles that are being serviced by an existing dealership service center that are in need of new tires, or the Potential customer base), wherein the tire tread index varies according to carline and represents a percentage of cars serviced by

the service center which have tires in need of replacement (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales);

determining a tire sales goal for the service center (Page 3, paragraph [0032]; discloses that the system can automatically adjust a product schedule and it would obvious that the sales goal can be determined); and

calculating projected tire sales by adding an average retail tire price for tire associated with each carline to a charge for services involved in mounting and balancing a tire to generate sum, multiplying the sum by the sales goal, scaling to the time period, and summing the tires sales for each carline to determine a total projected tire sales (Calculating the projected sales) (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales).

Burris fails to explicitly disclose that the calculation is for maximum sales.

Byrd, which discloses inventory management, teaches that it is old and well known to track and calculate Maximum sales (Page 3; teaches that part of tracking inventory is knowing sales volume like average sales, maximum sales, what is on hand, etc. all of this information would be necessary for calculating projected sales);

Therefore, from this teaching of Byrd, it would have been obvious to one skilled in the art at the time the invention to include in the system and method of Burris that the calculations would include maximum sales as taught by Byrd since these calculations are considered to be basic necessities when calculating projected sales.

The Examiner asserts that the type of data in this case information regarding the sale of tires is considered to bee non-functional since the information itself fails to further limit the steps of the method in anyway. Furthermore, the type of information is considered to be non-functional descriptive material since it has little if anything to the step of the method. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed non-functional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d at 1384-85, 217 USPQ at 403; see also Diamond v. Diehr, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See In re Lowry, 32 F.3d 1336. 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. Such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate. The Examiner asserts that the data identifying the type of information for the purchased good adds little, if anything, to the claimed structure of the system and thus does not serve as limitations on the claims to distinguish over the prior art. Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or

impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the type of information gathered does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

For example if the items for sale were computers and their corresponding parts would change. The operational data would pertain to average number of sales of computers or accessories, the hours the store would be open and the different computers for sale. The Maximum sales would depend on how many computers were sold on a given night with a set number of hours open. The index could refer to the percentage of customers who might night to have their systems upgraded or replaced. By replacing the information being gathered the steps do not change and therefore the information is non-functional.

As per claim 2, the combination of Burris and Byrd teaches the above-enclosed invention, Burris further discloses that it is old and well known that the time period is one year (Page 1, paragraph [0004]; discloses that it is old and well known to run reports yearly).

As per claims 3 and 13, the combination of Burris and Byrd teaches the above-enclosed invention, while the combination of Burris and Byrd fails to explicitly disclose that the operational data further includes a number of new, used and certified cars sold per year, charge for mount and balance, and employee pay rate per hour. However the Examiner asserts that this information would have been obvious to anyone working in

the field of tire sales would take this information into consideration while projecting future sales.

Further as stated in the above example given in claim 1, when selling computers the information gather could pertain to the number of new and refurbished computers the charge for diagnostic and the employee rate per hour since this information would be needed to determine the potential sales, for example if each new computer goes through a diagnostic before being sold and each system to calculate the sales one would need to calculate the price of each unit sold, and any service that would need to be performed on that system. To calculate the profits of the system the total sales would have to be determined, minus the money spent acquiring the parts and the money paid to employees. All of this information would be needed to determine projected profits.

Furthermore, the type of information is considered to be non-functional descriptive material since it has little if anything to the step of the method. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed non-functional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d at 1384-85, 217 USPQ at 403; see also Diamond v. Diehr, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See In re Lowry, 32 F.3d 1336. 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the

claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. Such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate. The Examiner asserts that the data identifying the type of information for the purchased good adds little, if anything, to the claimed structure of the system and thus does not serve as limitations on the claims to distinguish over the prior art. Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the type of information gathered does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claims 4, 5 and 14, the combination of Burris and Byrd teaches the above-enclosed invention, while the combination of Burris and Byrd fails to explicitly disclose wherein the tire tread index is no greater than about 30% or is about 10% to about 15%.

However the Examiner asserts that the tire tread index could be any value the value of the index does not alter or change the method steps but rather only alters the output or final result. The Examiner asserts that this information is considered to be non-functional descriptive material. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed non-functional descriptive

material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d at 1384-85, 217 USPQ at 403; see also Diamond v. Diehr, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See In re Lowry, 32 F.3d 1336. 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. Such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate. The Examiner asserts that the data identifying the type of information for the purchased good adds little, if anything, to the claimed structure of the system and thus does not serve as limitations on the claims to distinguish over the prior art. Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the type of information gathered does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 7, the combination of Burris and Byrd teaches the above-enclosed invention, while the combination of Burris and Byrd fails to explicitly disclose where the

existing service center is affiliated with a car dealership that sells new, used, and certified pre-owned cars.

However the Examiner asserts that the fact that the service center is affiliated with a car dealership that sells new, used, and certified pre-owned cars is specific to the tire industry but fails to limit the steps of the method in anyway. The Examiner asserts that this information is considered to be non-functional descriptive material. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed non-functional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d at 1384-85, 217 USPQ at 403; see also Diamond v. Diehr, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See In re Lowry, 32 F.3d 1336. 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. Such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate. The Examiner asserts that the data identifying the type of information for the purchased good adds little, if anything, to the claimed structure of the system and thus does not serve as limitations on the claims to

distinguish over the prior art. Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the type of information gathered does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 12, Burris discloses a method of evaluating potential sales and business opportunities relating to establishing sales (Page 1, paragraph [0001]; discloses that the invention is directed toward tracking and forecasting sales) comprising:

collecting operational data from the service center (retail outlet), wherein the operational data comprises an average number of repair order requests (average sales), hours of operation, and identification of one or more carlines serviced (products) (Page 1, paragraph [0003]; discloses that it is old and well known to collect various forms of data, from various sources in order to predict potential sales, Page 1, paragraph [0015]; discloses that various sources of data are obtained, Page 3, paragraph [0028]; discloses that the information can be created based on the needs of the specific user. While the information gathered is not the same since no specific industry is mentioned in Burris, the Examiner asserts that the information itself would have been obvious to one of ordinary skill in the tire industry since it would have been obvious to know the number of requests, the hours of operation and the different

products being sold all of this information would have been needed in calculating the potential sales);

calculating a maximum expected number of tires (products sold) which may be sold for each carline per time period, wherein the maximum is equal to the average number of repair order requests multiplied by the number of days the service center is open per time period multiplied by four (4) tires multiplied by a tire tread index (which is the percentage of vehicles that are being serviced by an existing dealership service center that are in need of new tires, or the Potential customer base), wherein the tire tread index varies according to carline and represents a percentage of cars serviced by the service center which have tires in need of replacement (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales);

determining a tire sales goal for the service center (Page 3, paragraph [0032]; discloses that the system can automatically adjust a product schedule and it would obvious that the sales goal can be determined); and

calculating projected tire sales by adding an average retail tire price for tire associated with each carline to a charge for services involved in mounting and balancing a tire to generate sum, multiplying the sum by the sales goal, scaling to the time period, and summing the tires sales for each carline to determine a total projected tire sales (Calculating the projected sales) (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales).

calculating savings associated with the tire sales, wherein a certified pre-owned savings is calculated by comparing a cost associated with outsourcing the replacement of certified pre-owned car tires with a cost associated with internally supplying new tires to the certified pre-owned cars (Page 2, paragraph [0025]; discloses that the invention can forecast information, it would be obvious that this information could be saving about different possible outcomes); and

calculating the business opportunity by adding together the total projected tire sales and the certified pre-owned savings (Page 2, paragraph [0025]; discloses that the invention can forecast information, it would have been obvious to calculate different scenarios to help determine what is the best course of action in a new venture such as determining the savings associated with one choice compared to another the information itself being about a tire sales adds little if anything to claimed method).

Burris fails to explicitly disclose that the calculation is for maximum sales.

Byrd, which discloses inventory management, teaches that it is old and well known to track and calculate Maximum sales (Page 3; teaches that part of tracking inventory is knowing sales volume like average sales, maximum sales, what is on hand, etc. all of this information would be necessary for calculating projected sales);

Therefore, from this teaching of Byrd, it would have been obvious to one skilled in the art at the time the invention to include in the system and method of Burris that the calculations would include maximum sales as taught by Byrd since these calculations are considered to be basic necessities when calculating projected sales.

The Examiner asserts that the type of data in this case information regarding the sale of tires is considered to bee non-functional since the information itself fails to further limit the steps of the method in anyway. Furthermore, the type of information is considered to be non-functional descriptive material since it has little if anything to the step of the method. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed non-functional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d at 1384-85, 217 USPQ at 403; see also Diamond v. Diehr, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See In re Lowry, 32 F.3d 1336. 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. Such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate. The Examiner asserts that the data identifying the type of information for the purchased good adds little, if anything, to the claimed structure of the system and thus does not serve as limitations on the claims to distinguish over the prior art. Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or

impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the type of information gathered does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

For example if the items for sale were computers and their corresponding parts would change. The operational data would pertain to average number of sales of computers or accessories, the hours the store would be open and the different computers for sale. The Maximum sales would depend on how many computers were sold on a given night with a set number of hours open. The index could refer to the percentage of customers who might night to have their systems upgraded or replaced. By replacing the information being gathered the steps do not change and therefore the information is non-functional. The savings could come from outsourcing repairs to refurbished computers which could have out dated elements and require more investment then current systems.

16. **Claims 6, 8-11, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burris et al. (US 2003/0208394 A1) hereafter Burris, in view of Byrd, further in view of Examiner's Official Notice**.

As per claim 6 and 15, the combination of Burris and Byrd teaches the above-enclosed invention, while Burris does disclose making various calculations based on the information being gathered (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales). However, it fails to

explicitly disclose calculating total savings, net profit, warranty costs, capital investment, return on investment, and total equipment costs.

However, the Examiner is taking official notice that it is old and well known to make various calculations and that the calculations themselves are not novel. It is common for a company or business to calculate total savings, net profit, warranty costs, capital investment, return on investment, and total equipment costs as part of doing business. It is often required to calculate net profit for example to determine if the venture will be a profitable one, or return on investment to determine if the investment is sound and if investors will back the venture.

Therefore, from this teaching of Examiner's Official Notice, it would have been obvious to one skilled in the art at the time the invention to include in the system and method provided by the combination of Burris and Byrd with the basic calculations taught by the Examiner's Official Notice since these calculations are considered to be basic calculations that all businesses perform to ensure that they are making a sound financial decision.

As per claims 8 and 17, the combination of Burris and Byrd teaches the above-enclosed invention, while Burris does disclose making various calculations based on the information being gathered (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales). However, it fails to explicitly disclose calculation of capital investment cost, wherein the capital investment cost is determined by adding together cost of purchasing tire installation equipment and inventory investment costs, wherein inventory investment cost is

calculated by dividing the annual tires by the inventory turn goal and multiplying by an average wholesale tire price associated with a carline.

However, the Examiner is taking official notice that it is old and well known to make various calculations and that the calculations would include such calculations such as capital investment cost. A company would do this sort of calculation to determine what the investment is for the product and to ensure they can afford to take on these new costs.

Therefore, from this teaching of Examiner's Official Notice, it would have been obvious to one skilled in the art at the time the invention to include in the system and method provided by the combination of Burris and Byrd with the basic calculations taught by the Examiner's Official Notice since these calculations are considered to be basic calculations that all businesses perform to ensure that they are making a sound financial decision.

As per claim 9, the combination of Burris and Byrd teaches the above-enclosed invention, Burris does disclose making various calculations based on the information being gathered (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales). Byrd teaches tracking status of inventory (Page 5, under the status heading; teaches that inventory is tracked in various ways).

However the combination fails to explicitly disclose including the calculation of inventory space requirements.

However, the Examiner is taking official notice that it is old and well known to make various calculations and that the calculations would include such calculations such as inventory space requirements. A company would do this sort of calculation to determine what the inventory space requirements are so they don't have goods they can't stock.

Therefore, from this teaching of Examiner's Official Notice, it would have been obvious to one skilled in the art at the time the invention to include in the system and method provided by the combination of Burris and Byrd with the basic calculations taught by the Examiner's Official Notice since these calculations are considered to be basic calculations that all businesses perform to ensure that they are making a sound financial decision and not taking on obligations they can't maintain.

As per claim 10, the combination of Burris and Byrd teaches the above-enclosed invention, Burris does disclose making various calculations based on the information being gathered (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales).

However the combination fails to explicitly disclose including the calculation of cost of satisfying warranty claims wherein the cost is determined by multiplying a number of new annual car sales for the dealership by a warranty factor or number of warranty claims.

However, the Examiner is taking official notice that it is old and well known to make various calculations and that the calculations would include such calculations such as cost of satisfying warranty claims. A company would do this sort of calculation

to determine what the cost of fulfilling warranties would be, given that the information is directed toward tires it is old and well know that tires come with warranties and thus would have a related cost associated with fulfilling those warranties.

Therefore, from this teaching of Examiner's Official Notice, it would have been obvious to one skilled in the art at the time the invention to include in the system and method provided by the combination of Burris and Byrd with the basic calculations taught by the Examiner's Official Notice since these calculations are considered to be basic calculations that all businesses perform to ensure that they are making a sound financial decision and not taking on obligations they can't maintain.

As per claim 11, the combination of Burris and Byrd teaches the above-enclosed invention, Burris does disclose making various calculations based on the information being gathered (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales).

However the combination fails to explicitly disclose including the calculation of a loyalty factor, wherein the loyalty factor is determined by dividing the annual tires sold by a loyalty variable.

However, the Examiner is taking official notice that it is old and well known to make various calculations and that the calculations would include such calculations such as a loyalty factor. A company would do this sort of calculation to determine what the loyalty of their customers would be based on how often they return to the service center for maintenance.

Therefore, from this teaching of Examiner's Official Notice, it would have been obvious to one skilled in the art at the time the invention to include in the system and method provided by the combination of Burris and Byrd with the basic calculations taught by the Examiner's Official Notice since these calculations are considered to be basic calculations that all businesses perform to ensure that they maintain a good relationship with their customers and ensure that they have future sales.

As per claim 16, the combination of Burris and Byrd teaches the above-enclosed invention, while Burris does disclose making various calculations based on the information being gathered (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales).

However fails to explicitly disclose wherein the cost of internally supplying tires is calculated by multiplying the number of annual certified pre-owned cars sold by a pre-owned car service goal and adding in labor costs for replacing the tires, and wherein the cost of outsourcing the tire replacement is calculated with the average retail tire price.

However, the Examiner is taking official notice that it is old and well known to make various calculations and that the calculations would include such calculations such as a comparison between in house costs and outsourcing a job. The details of this job would depend on the industry and the products being sold. A business dealing in tire resale would to consider the number of possible tires they would have to replace as well as the cost of having them installed meaning how much they would have to pay workers. These calculations would have to be done simply to know if it is cost effective to offer this service while still maintaining a competitive cost for the service. It is often

the procedure of a company to evaluate various options in order to discover the most cost effective and profitable solution.

Therefore, from this teaching of Examiner's Official Notice, it would have been obvious to one skilled in the art at the time the invention to include in the system and method provided by the combination of Burris and Byrd with the basic calculations taught by the Examiner's Official Notice since these calculations are considered to be basic calculations that all businesses perform to ensure that they maintain to evaluate various options in order to discover the most cost effective and profitable solution.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL R. FISHER whose telephone number is (571)270-5097. The examiner can normally be reached on Mon/Fri [7:30am/5pm] with first Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PRF

/Tan Dean D. Nguyen/
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3/30/09